

REMARKS/ARGUMENTS

Claims 1-47 are pending. The specification has been objected to because of an embedded hyperlink. To facilitate prosecution, the specification has been amended to delete the term "HTTP://www.invoice.com". In view of the above amendment to the specification, it is respectfully requested that the objection to the specification be withdrawn.

The Office Action alleges that the "OFFICIAL NOTICE presented in the prior Action as to the equivalence of 'VCRs' and 'digital storage devices' for their use in the recording art and the selection of any of these known equivalents to record and store televised programming being within the level of ordinary skill in the art was not traversed and is accordingly taken as an admission of the fact noted" (Office Action, page 3, lines 7-11). This official notice was (and still is) presented in relation to rejections of dependent claims 7, 31, and 46 (see, for example, page 11, lines 3-10 of the Office Action). However, in applicants' response of November 13, 2003, applicants argued the patentability of independent claims from which dependent claims 7, 31, and 46 depend. Hence, in applicants' view, it was not necessary to

address dependent claims 7, 31, and 46 and argue their patentability over the cited references separately from the patentability of the parent independent claims. This does not mean that applicants admitted the equivalence of "VCRs" and "digital storage devices." In fact, applicants note that there are differences between "VCRs" and "digital storage devices." For example, conventional VCRs are not digital devices. Also, many digital storage devices are capable of randomly accessing different programs stored thereon, while VCRs are not randomly accessible. However, whether a VCR is "equivalent" to a "digital storage device" depends on the context of the claim, the invention, and the prior art in each particular instance. If the base independent claims are allowable, this issue with respect to the dependent claims 7, 31, and 46 is moot. Accordingly, applicants respectfully disagree with the Examiner's contention that applicants admitted the Examiner's above-mentioned official notice was correct.

Claims 24 and 41 have been rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that these claims are supported by the written description and that the claimed "second database" is not the same as the claimed

"second storage device." For example, in paragraph [0058] of the published patent application (U.S. patent publication No. 2002/0059599), the specification describes that "a user can select certain types of programs to be recorded, watched, or retrieved for digital storage before any particular program is available to the electronic program guide. Moreover, each time a connection is made to an on-line service, the software can search the database and set the selected types of programs to be recorded and/or retrieved for digital storage" (emphasis added). Accordingly, it is respectfully requested that the above-mentioned rejection to claims 24 and 41 be withdrawn.

Claims 1, 3, 6, 8-13, 20-22, 24, 25, 27, 30, 32-34, 40, and 41 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Lawler et al. U.S. patent 5,585,838. Claims 2, 4, 5, 7, 23, 26, 28, 29, 31, and 42-47 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler et al. U.S. patent 5,585,838. Claims 14-16, 35, and 36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler et al. U.S. patent 5,585,838 in view of Knee et al. U.S. patent 5,589,892. Claims 17, 18, 37, and 38 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler et al. U.S. patent 5,585,838 in view of Lawler U.S.

patent 5,758,259. Claims 19 and 39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler et al. U.S. patent 5,585,838 in view of Harrison U.S. patent 5,694,163. Applicants submit that all of the claims currently pending in this application are patentably distinguishable over the cited references, and reconsideration and allowance of this application are respectfully requested.

Independent claim 1 includes, among other features, "a storage device electrically coupled to the second network for storing television programs" and "a processor electrically coupled to the second network programmed for accessing the database to display a portion of the television schedule information on the display monitor in a guide format and for controlling the storage device to store a television program selected from the displayed television schedule information." Thus, the claimed storage device and processor are electrically connected through the second network.

Lawler (in FIGS. 1 and 2) describes a viewer station 16 including "an interactive station controller 18, a video display 20, and a user input device 22" (column 5, lines 12-14). FIG. 2 of Lawler depicts a block diagram of a viewer station 16. The viewer station "includes an interactive

station controller 18 which is sometimes referred to as a set top box, at least one video display 20 such as a television, and an input device 22 such as an infrared remote control. Although it is shown distinct from video display 20, the interactive station controller 18 could alternatively be integral with video display" (column 7, lines 8-14). A CPU 58, within a viewer station 16, controls analog-based or digital-based programming (column 7, lines 47-48).

The Office Action alleges that network 14 of FIG. 1 in Lawler is equivalent to the "second network" of claim 1. Nevertheless, there is no teaching in Lawler that the CPU 58, within a viewer station 16, controls a storage device over network 14 to store a television program selected from the displayed television schedule information, displayed from the network 14. Thus, network 14 of Lawler is not and cannot be equivalent of the claimed "second network." Accordingly, applicants' claim 1 is not anticipated by Lawler.

Additionally, dependent claim 3 recites "wherein the second network is a home network." In rejecting this claim, the Examiner takes a different approach from the application of Lawler to claim 1, stating that "the 'first network' [14] is the network operable to connect the viewer stations [16] with

the headend [12] and the 'second network' is an inherent 'home network' (Col. 5, Lines 8-12) between the interconnected devices [18/20/22 + VCR] comprising the viewer station [16]" (Office Action, page 7, lines 10-14).

Applicants respectfully disagree. First, it is improper to read network 24 of Lawler onto the claimed first network and network 14 of Lawler onto the claimed second network with respect to claim 1, but read network 14 onto the claimed first network and the connections between different components of the viewer station 16 onto the claimed second network, with respect to claim 3. Second, the disclosed (direct) connections between different components of the viewer station 16 are not an inherent "home network." The specification sufficiently describes a "home network" to be different from (direct) connections between different components of the viewer station 16, such as the station controller 18, video display 20, and user input device 22 of FIG. 2 of Lawler, cited by the Office Action. For example, referring to FIG. 1, the specification states that a "line 37 is used to connect other devices to VCR 34. Other devices can also be connected in series between VCR 34 and television 32 via line 38. With this configuration, computer 12 (or computer

system 10) and television 32 (or television system 30) can be located in different rooms within a private residence or a commercial building" (§ [0028]). Furthermore, the specification emphasizes that "computer 12, television 30, VCR 37 and all additional electronic devices could be on a home network. In this arrangement, no transmitters or internal receivers would be necessary" (§ [0046]).

In fact, by emphasizing a viewer station and interconnected peripherals to that station in FIG. 2, Lawler teaches away from a home-networked viewer system connecting a processor, a storage device, a display monitor, a television tuner, and an input device, as recited by claim 3. Accordingly, dependent claim 3 is also patentable over the cited references for the same reasons that independent claim 1 is patentable, and for the additional reasons stated above.

Independent claim 25 includes, among other features, "controlling a storage device electrically coupled to the second network for storing a television program selected from the displayed television schedule information," and independent claim 42 includes, among other features, "a storage device electrically coupled to the network for storing television programs received from the network; and a processor

electrically coupled to the network programmed for accessing the database to display a portion of the television schedule information on a display monitor and for controlling the storage device to store via the network a television program selected from the displayed television schedule information."

Again, for the reasons stated above regarding claim 1, network 14 of Lawler is not and cannot be equivalent to the claimed "second network." Accordingly, claims 25 and 42 are also not anticipated by Lawler.

Dependent claims 27 and 43 include the additional feature of "wherein the second network is a home network." As discussed above with respect to claim 3, the disclosed (direct) connections between different components of the viewer station 16 are not an inherent "home network." Therefore, claims 27 and 42 are patentable over Lawler for the additional feature of a home network that they include therein.

In short, independent claims 1, 25, and 42 define a novel and nonobvious invention over the cited references. Dependent claims 2-24, 26-41, and 43-47 are dependent from claims 1, 25, and 42, respectively, and therefore include all the features of their respective independent claims and additional features therein. Accordingly, these claims are

also allowable over the cited references, as being dependent from allowable independent claims and for the additional features they include therein. For that reason, the rejection of these dependent claims are not directly addressed here. This, however, does not constitute an admission or denial of any of the statements made in the Office Action with respect to such dependent claims.

In view of the foregoing remarks, it is respectfully submitted that this application is now in condition for allowance, and accordingly, reconsideration and allowance are respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Laura A. Sheridan". The signature is written in black ink and is positioned above a horizontal line.

Laura A. Sheridan
Reg. No. 48,446
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax: (212) 596-9090